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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/498,944	02/04/2000	Christopher Warnock	EBRY0001	9493
22862	7590	08/23/2010	EXAMINER	
GLENN PATENT GROUP 3475 EDISON WAY, SUITE L MENLO PARK, CA 94025			LE, NANCY LOAN T	
			ART UNIT	PAPER NUMBER
			3621	
			NOTIFICATION DATE	DELIVERY MODE
			08/23/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

eptomatters@glenn-law.com

Office Action Summary	Application No. 09/498,944	Applicant(s) WARNOCK ET AL.	
	Examiner NANCY T. LE	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 15, 17-21, 55-75 and 78-86 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 15, 17-21, 55-75 and 78-86 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>28 April 2010</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

Applicant's Amendment/Remarks filed on *8 April 2010* is acknowledged.

All references to the capitalized versions of “Applicants” refer specifically to the Applicants of record. Any references to lower case versions of “applicant” or “applicants” refer to any or all patent “applicants”. Unless expressly noted otherwise, references to “Examiner” refers to the Examiner of record while reference to or use of the lower case version of “examiner” or “examiners” refers to examiner(s) generally.

This paper is given Paper No. 20100703 by the Examiner. This Paper No. is for reference purposes only.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 4/28/2010 was filed after the mailing date of the non-final action on 1/8/2010. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Status of Claims

Claims *1-3, 15, 17-21, 55-75 and 78-86* have been examined and pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 15, 17-21, 55-75 and 78-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,892,900 (hereinafter “Ginter”) and US Patent Application No. 2002/0143807 (hereinafter “Komatsu”).

Ginter discloses a computer-implemented method for user access to document content using a logic client device comprising:

- delivering to a user of said client logic device, via a document server, a first user viewable version of the actual contents of a specific document residing at a said document server on a first cost basis, said first user viewable version being protected by a security server to prevent the user from performing a standard operation on said version, said standard operation consisting of any of copying, printing or saving (*i.e., distributing the main stream, which allows user to view the content in limited version, e.g., in low resolution, to a user in response to a selection by the user - see Ginter, Fig. 1 and Fig. 3; Fig. 72B – 72D; col./lines 53/39 -56/65, 140/25-38*);

- calculating with said document server a charge to permit the user to perform a requested standard operation on a user-selected portion of said specific document on a second cost basis (*Ginter, col./lines 140/25-38*);
- delivering user-requested pages of a specific document from a document server in a first user-viewable version comprising a form protected by a security server to a user of a client logic device to permit said user viewing the actual contents of said pages of said specific document and selecting by said user but not printing, copying or saving by the user (*i.e., distributing the main stream, which allows user to view the content in limited version, e.g., in low resolution, to a user in response to a selection by the user - see Ginter, Fig. 1 and Fig. 3; Fig. 72B – 72D; col./lines 53/39 -56/65, 140/25-38*).

Ginter does not expressly disclose:

- delivering to said user, via said document server, a second version of the actual contents of said specific document residing at said document server comprising said user-selected portion of said specific document, wherein a user requested standard operation is completed, in coordination with said document server, upon payment of the calculated charge.

Komatsu, however, teaches:

- delivering to said user, via said document server, a second version of the actual contents of said specific document residing at said document server comprising said user-selected portion of said specific document, wherein a

user requested standard operation is completed, in coordination with said document server, upon payment of the calculated charge;
(i.e., distributing content in an enhanced resolution upon payment – see *Komatsu, at least the Abstract*, Fig. 1, Fig. 2; ¶0019; ¶0033; ¶0036; ¶0037; ¶0041; ¶0045; ¶0046; ¶0048; ¶0058; ¶0064, ¶0071, ¶0074-¶0079) to provide (deliver) a higher quality version of the data (i.e., a second version of the actual contents of a specific document) to the customer (user) over the network if the customer is entitled (i.e., upon payment) to receive it.

Ginter and Komatsu are analogous art since they are from the same field of endeavor of protecting/controlling content usage.

Therefore, it would have been obvious to an ordinary skill in the art to motivate to add to the system of Ginter the aspect of:

- *“delivering to said user, via said document server, a second version of the actual contents of said specific document residing at said document server comprising said user-selected portion of said specific document, wherein a user requested standard operation is completed, in coordination with said document server, upon payment of the calculated charge”,*

as taught in the system of Komatsu to provide (deliver) a higher quality version of the data (i.e., a second version of the actual contents of a specific document) to a customer (user) over the network if the customer is entitled (i.e., upon payment) to receive it.

Since the claimed invention is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Response to Arguments

Applicant's arguments with respect to claims 1 and 67 have been considered but are moot in view of the new ground of rejection as discussed above.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US 2004/0239681

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the examiner should be directed to NANCY LOAN T. LE whose telephone number is (571) 272-7066. The examiner can normally be reached on Monday - Friday, 9am - 6:00pm Eastern Standard Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ANDREW J. FISCHER can be reached on (571) 272-6779.

For official/regular communication, the fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

For informal/draft communication, the fax number is (571) 273-7066 (Rightfax).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NANCY T. LE
Examiner, Art Unit 3621

/EVENS J. AUGUSTIN/
Primary Examiner, Art Unit 3621